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Atty Dkt No. GP-303003 (GM-0363PUS)

Remarks

The following remarks are intended to be fully responsive to the Office Action mailed October 18, 2004.

Claims 1-14 are pending. Claims 13 and 14 are withdrawn from consideration. Claims 1-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zaguroli (5,598,785) in view of Sherburne (3,140,848). Applicants have amended claims 1 and 11.

As recited in the MPEP, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP § 2142.

The Examiner is reminded that three basic criteria must be met to establish *prima facie* obviousness. MPEP § 2143. First, there must be some suggestion or motivation to modify a reference or combine teachings. *Id.* Second, there must be reasonable expectation of success. *Id.* Third, the prior art reference or references must teach or suggest all the claim limitations. *Id.*

None of the three basic criteria to establish *prima facie* obviousness are met.

None of the cited references teaches or suggests all claim limitations.

Independent claim 1 has been amended to clarify the limitation "positioned laterally with respect to the beam." Amended claim 1 recites a "material handling system comprising: a beam; a rail at least partially defining a passage; a track within the passage; and a hanger operatively connected to the beam and the rail **such that at least a portion of the rail is at the same vertical height as at least a portion of the beam so as to be positioned laterally with respect to the beam.**" (emphasis added). With respect to the third criterion, neither of the references cited, either alone or in combination, teaches or suggests "a hanger operatively connected to the beam and the rail **such that at least a portion of the rail is at the same**

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vertical height as at least a portion of the beam so as to be positioned laterally with respect to the beam," as recited by claim 1.

The Examiner states that "Zaguroli discloses trolley track rail 12 provided with hanger 10 for connecting to a support." The Examiner admits that "Zaguroli does not show the support where the hanger is hanged from." The Examiner then states that "Sherburne, Figure 1, shows a hanger provided with fastening means for mounting the hanger to overhead I-beam 4."

Zaguroli may teach a track rail, and Sherburne may teach a hanger from which an object may be suspended with respect to an I-beam, but neither reference teaches or suggests that "at least a portion of the rail is at the same vertical height as at least a portion of the beam so as to be positioned laterally with respect to the beam." Thus, claim 1 recites a limitation that is neither taught nor suggested by the references cited, and, accordingly, the rejection of claim 1 is improper.

Independent claim 8 similarly recites "connecting a rail to the horizontally-oriented beam such that **at least a portion of the rail is positioned laterally with respect to the beam.**" (emphasis added). Accordingly, the analysis presented for claim 1 also applies to claim 8. Moreover, claim 8 recites a "method of **retrofitting a material handling system having a horizontally-oriented beam defining an exposed track**, the method comprising: **connecting a rail to the horizontally-oriented beam.**" Neither Sherburne nor Zaguroli teaches or suggests retrofitting a horizontally-oriented beam defining an exposed track by connecting a rail to the horizontally-oriented beam that defines an exposed track. Sherburne may teach a hanger for supporting pipe from an I-beam, but Sherburne does not teach that the I-beam is part of a material handling system defining an open track. Accordingly, the rejection of claim 8 is improper.

Similar to claim 1, independent claim 11 has been amended to clarify the limitation "positioned alongside the beam." Amended claim 11 recites "a hanger having a fastening element operatively connecting the hanger to the beam, and **a cantilever portion supporting the rail such that at least a portion of the rail is at the same vertical height as at**

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least a portion of the beam so as to be positioned alongside the beam.” (emphasis added).

Thus, the analysis presented for claim 1 also applies to claim 11.

There is not a reasonable expectation of success in combining the cited references to achieve the claimed invention.

Regarding the second criterion required to establish *prima facie* obviousness, there is not a reasonable expectation of success. The track rail 12 of Zaguroli is configured so that it is suspended along its midsection at Tee flanges 36, with hat-shaped sections 14 and 16 protruding laterally. It is apparent that the pipe support rod 20 of Sherburne is positioned almost immediately adjacent to the edge 5b of the top flange 5 of I-beam 4. The proximity of the support rod 20 to the I-beam is not problematic in supporting “piping and related conduits,” the purpose of Sherburne, because the relatively small sectional area of pipes and conduits fits easily between the upper and lower I-beam flanges.

However, the proximity of the support rod 20 with respect to the I-beam likely prevents the successful combination of Zaguroli and Sherburne to result in the invention as claimed. Claim 1 recites that “at least a portion of the rail is at the same vertical height as at least a portion of the beam so as to be positioned laterally with respect to the beam.” The proximity of hanger 20 to the I-beam would likely render impossible the attachment of Zaguroli’s rail laterally with respect to the I-beam because the lower flange of the I-beam would cause physical part interference with the protruding hat-shaped sections 14, 16 of the rail 12.

In contrast, the Applicants’ hangers 39, 39’ (as shown in Figures 1 and 2 of the present application), have cantilevered portions 56, 56’. As stated in paragraph 0021 of the present application, **“the cantilever portion 56’ extends sufficiently outwardly from the I-beam 12 to enable at least a portion of the rail 14 to be positioned laterally with respect to the I-beam.”** (emphasis added). See also paragraph 0005 of the present application, which states the “hanger is configured so that at least a portion of the structural member projects sufficiently outwardly from the beam to enable at least a portion of the enclosed track rail to be laterally positioned with respect to the beam.”

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Thus, the second criterion necessary to establish *prima facie* obviousness is not met, and accordingly the rejection of claim 1 is improper.

The analysis presented for claim 1 regarding likelihood of success also applies to claim 8. Claim 11 specifically recites **"a cantilever portion supporting the rail such that at least a portion of the rail is at the same vertical height as at least a portion of the beam so as to be positioned alongside the beam."** Any "cantilever portion" found in Sherburne does not protrude sufficiently outwardly "such that at least a portion of the rail is at the same vertical height as at least a portion of the beam so as to be positioned alongside the beam."

The Examiner has not provided an adequate motivation or suggestion to combine the teachings of Sherburne and Zaguroli.

Regarding the first criterion necessary to establish *prima facie* obviousness, the Examiner provides, as motivation or suggestion to combine the teachings of Zaguroli with Sherburne, that "it would have been obvious to one skilled in the art to provide fastening means to the hanger of Zaguroli for allowing the hanger to be mounted to available overhead I-beams, in a manner similar to that taught by Sherburne, **so as to achieve expected advantages thereof, such as quick and easy connections and disconnections.**" (emphasis added).

However, "to achieve expected advantages thereof" is not, by itself, a motivation or suggestion. The example of one of the "expected advantages" provided by the Examiner, i.e., "quick and easy connections and disconnections," is not found in the knowledge of those skilled in the art, nor is it found in the references cited by the Examiner. Indeed, the motivation or suggestion is found only in Applicants' disclosure.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of impermissible hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). The Examiner merely uses the teachings of the Applicants' disclosure

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as motivation or suggestion to combine references. Accordingly, the third criterion for establishing *prima facie* obviousness is not satisfied with respect to independent claims 1, 8, and 11.

Claims 2-7 ultimately depend from claim 1 and are therefore allowable for at least the same reasons that claim 1 is allowable. Claims 9 and 10 ultimately depend from claim 8 and are therefore allowable for at least the same reasons that claim 8 is allowable. Claim 12 depends from claim 11 and is therefore allowable for at least the same reasons that claim 11 is allowable.


Conclusion

The amendments and remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested.

The undersigned attorney is acting in a representative capacity in this Application under 37 C.F.R. §1.34(a). If further proof of authority to act in a representative capacity is required in this Application, please notify the undersigned via the correspondence address associated with this Application.

Respectfully submitted,

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